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KILYK & BOWERSOX, P.L.L.C.
3603 CHAIN BRIDGE ROAD
SUITE E
FAIRFAX, VA 22030

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| EXAMINER |
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SINES, BRIAN J

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| ART UNIT | PAPER NUMBER |
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1797

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04/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/628,281 | Applicant(s) HARROLD, MICHAEL P. | |
| | Examiner Brian J. Sines | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/42008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The previous prior art rejections have been modified in view of applicant's arguments. The previous rejection of the claims under 35 U.S.C. 112, second paragraph, has been withdrawn. It should be noted that the method of claim 1 does not specify that each of the method steps be performed in any specific sequence. The preamble to claim 1 merely indicates that the claimed method comprises or includes the following recited steps. For claim interpretation and examination purposes, a prior art method can anticipate the claimed method if the reference teaches all of the recited individual steps, but not necessarily in the same sequence as written. If the applicant intends that the method steps be performed in a specific sequence, the claim should be written to clearly indicate so.

The After Final Rejection amendment has been entered.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 – 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

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which it is most nearly connected, to make and/or use the invention. Regarding claim 1, the scope of the term “excess diluent” is unclear. The specification does not clearly define a fluid volume amount that would be considered excess. What amount or range of fluid volume amount constitutes an “excess” amount of diluent? It is unclear as to what fluid volume amount would be considered excess and not merely a small amount of residual diluent fluid. It is unclear as to the demarcation between the volume amount of diluent used to saturate the purification material and the additional volume amount of diluent that would be considered an excess amount. In step 3 of the method recited in claim 1, the purification material is rendered free of excess diluent. However, it is unclear as to what volume amount the remaining diluent volume retained with the purification material would constitute. Is the purification material completely dry at this stage or is the purification material still moist with residual diluent?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 – 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

Regarding claim 1, the scope of the term “excess diluent” is unclear. The specification does not clearly define a fluid volume amount that would be considered excess. What amount or range of fluid volume amount constitutes an “excess” amount of diluent? It is unclear as to what

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fluid volume amount would be considered excess and not merely a small amount of residual diluent fluid. It is unclear as to the demarcation between the volume amount of diluent used to saturate the purification material and the additional volume amount of diluent that would be considered an excess amount. In step 3 of the method recited in claim 1, the purification material is rendered free of excess diluent. However, it is unclear as to what volume amount the remaining diluent volume retained with the purification material would constitute. Is the purification material completely dry at this stage or is the purification material still moist with residual diluent?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 17 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunt et al. (U.S. Pat. Appl. No. 2002/0110495) (“Hunt”).

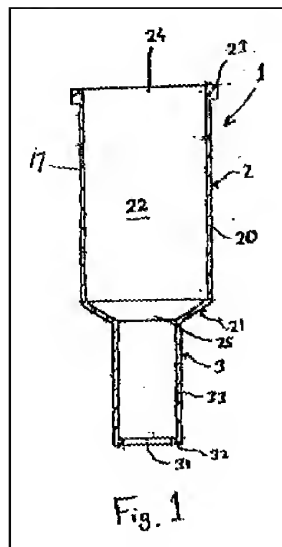
Regarding claims 1 and 23, Hunt teaches a method for purifying a fluid. Hunt teaches the step of providing a microfluidic purification device, e.g., sample holder 1, having an entry port 24, a purification column, e.g., column module 5 comprising cylindrical capsule 51, comprising a purification material comprising a packed bed 60 of particulate chromatography separation medium in fluidic communication with the entry port and an output port 31, and an output reservoir inside tube 8 in fluidic communication with the purification column (see paragraphs 5

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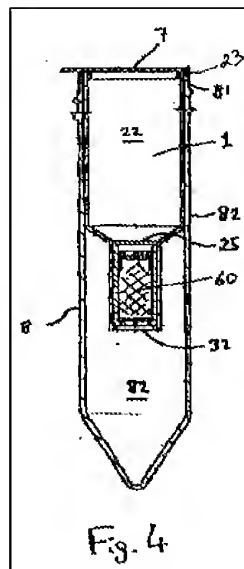
– 43 and 57 – 64; figures 1 – 4). Hunt teaches that the packed bed comprising a particulate resin can comprise various types of affinity resins for facilitating fluid sample purification (see paragraphs 65 – 87). Hunt teaches that the disclosed microfluidic device can process microliter fluid sample volumes (see paragraph 93). Hunt anticipates that the fluid sample to be processed is placed in the sample chamber 22 with a diluent or binding buffer and is driven through the column 60 into tube 8 (see, e.g., paragraphs 90 – 92 and 108). Hunt anticipates that the purification column is initially saturated with diluent or binding buffer so that the material in the fluid sample to be purified would bind with the affinity resin. It is anticipated that the purified sample after elution would be mixed with the remaining diluent flowing through the column and in the output reservoir or tube 8.

Hunt teaches that a liquid, which can be interpreted as being the diluent, is provided with the sample in the sample chamber of the purification device that also comprises the bed of particulate separation medium (see paragraph 30). Hunt teaches that the fluid sample to be separated is placed into the purification device through an entry port, e.g., top opening 24, into the sample chamber 22 of the purification device (see, e.g., paragraph 91). The device is centrifuged to pass the liquid of the sample through the column of the device for purification and the eluate is captured in a collection chamber beneath. Hunt teaches that the flow cross-section through the column bed is substantially smaller than the cross-section of the sample chamber 22 above the column 3 that contains the purification medium (see, e.g., paragraphs 58, 59 and 30; figure 1). The excess diluent solvent in the larger sample chamber would saturate the purification column. Therefore, it is inherent that the purification column would be saturated with diluent or buffer solvent.

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Hunt teaches that the sample and diluent can be driven through the purification by centrifugation (see, e.g., paragraph 91). As disclosed in paragraph 91, Hunt does not specifically teach that additional diluent is added during this centrifugation. Thus, the excess diluent can be driven through the column rendering the purification material free of any excess diluent solvent. The excess diluent and purified sample can be captured in the output reservoir indicated at 82 in the device configuration shown in figure 4. It is inherent that the purified sample and the removed diluent would be mixed together in the output reservoir.



Regarding claims 2 – 9, Hunt teaches the use of various hydraulic and pneumatic means, such as gravity, pump, vacuum, and including centrifugal or centripetal, for moving diluent and fluid sample through the device (see, e.g., paragraph 94).

Regarding claims 10 and 11, Hunt teaches that the fluid sample can comprise a biological sample, such as nucleic acids or antibodies (see, e.g., paragraph 3).

Regarding claims 12 – 15, Hunt anticipates the assembling of the microfluidic device comprising the purification column comprising the purification resin material and diluent or buffer prior to use (see, e.g., paragraphs 57 – 91).

Regarding claims 16 and 17, Hunt teaches the use of size exclusion or gel filtration resin and ion exchange resin (see, e.g., paragraphs 66 and 87).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt.

Regarding claims 1 and 23, Hunt teaches a method for purifying a fluid. Hunt teaches the step of providing a microfluidic purification device, e.g., sample holder 1, having an entry port 24, a purification column, e.g., column module 5 comprising cylindrical capsule 51, comprising a purification material comprising a packed bed 60 of particulate chromatography separation medium in fluidic communication with the entry port and an output port 31, and an output reservoir inside tube 8 in fluidic communication with the purification column (see paragraphs 5 – 43 and 57 – 64; figures 1 – 4). Hunt teaches that the packed bed comprising a particulate resin can comprise various types of affinity resins for facilitating fluid sample purification (see paragraphs 65 – 87). Hunt teaches that the disclosed microfluidic device can process microliter fluid sample volumes (see paragraph 93). Hunt teaches that the fluid sample to be processed is

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placed in the sample chamber 22 with a diluent or binding buffer and is driven through the column 60 into tube 8 (see, e.g., paragraphs 90 – 92 and 108). Hunt teaches that the purification column is initially saturated with diluent or binding buffer so that the material in the fluid sample to be purified would bind with the affinity resin. It would have been obvious to a person of ordinary skill in the art to mix the purified sample after elution with the remaining diluent flowing through the column and in the output reservoir or tube 8 as the sample fluid flows through the device during operation.

Hunt teaches that a liquid, which can be interpreted as being the diluent, is provided with the sample in the sample chamber of the purification device that also comprises the bed of particulate separation medium (see paragraph 30). Hunt teaches that the fluid sample to be separated is placed into the purification device through an entry port, e.g., top opening 24, into the sample chamber 22 of the purification device (see, e.g., paragraph 91). The device is centrifuged to pass the liquid of the sample through the column of the device for purification and the eluate is captured in a collection chamber beneath. Hunt teaches that the flow cross-section through the column bed is substantially smaller than the cross-section of the sample chamber 22 above the column 3 that contains the purification medium (see, e.g., paragraphs 58, 59 and 30; figure 1). The excess diluent solvent in the larger sample chamber would therefore saturate the purification column. Therefore, it would have been obvious to a person of ordinary skill in the art that the purification column would be saturated with diluent or buffer solvent.

Hunt teaches that the sample and diluent can be driven through the purification by centrifugation (see, e.g., paragraph 91). As disclosed in paragraph 91, Hunt does not specifically teach that additional diluent is added during this centrifugation step. Thus, the excess diluent can

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be driven through the column rendering the purification material free of any excess diluent solvent. The excess diluent and purified sample can be captured in the output reservoir indicated at 82 in the device configuration shown in figure 4. It is obvious to a person of ordinary skill in the art that the purified sample and the removed diluent would be mixed together in the output reservoir.

Furthermore, it would have been obvious to a person of ordinary skill in the art to remove excess diluent from the purification column thereby rendering the purification material free of excess diluent prior to introducing the fluid sample into the purification column in order to avoid further unnecessary dilution of the final purified sample and to eventually provide a final purified sample solution that is more concentrated.

Regarding claims 2 – 9, Hunt teaches the use of various hydraulic and pneumatic means, such as gravity, pump, vacuum, and including centrifugal or centripetal, for moving diluent and fluid sample through the device (see, e.g., paragraph 94).

Regarding claims 10 and 11, Hunt teaches that the fluid sample can comprise a biological sample, such as nucleic acids or antibodies (see, e.g., paragraph 3).

Regarding claims 12 – 15, Hunt teaches the assembling of the microfluidic device comprising the purification column comprising the purification resin material and diluent or buffer prior to use (see, e.g., paragraphs 57 – 91).

Regarding claims 16 and 17, Hunt teaches the use of size exclusion or gel filtration resin and ion exchange resin (see, e.g., paragraphs 66 and 87).

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Regarding claim 18, Hunt teaches that the sample can be processed in a few minutes (see, e.g., paragraph 91). Therefore, it would have been obvious to a person of ordinary skill in the art to contact the fluid sample with the purification material for at least one minute.

Regarding claims 19 – 21, Hunt teaches that the fluid sample can comprise a biological sample, such as nucleic acids (see, e.g., paragraph 3). The use of capillary electrophoresis, polymerase chain reaction and sequencing laboratory techniques with nucleic acids is very well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of these techniques with a fluid sample comprising nucleic acids in order to facilitate effective sample analysis.

Regarding claim 22, the use of buffers containing chloride ions with ion exchange chromatography media is very well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a fluid sample including chloride ions with the purification column as claimed in order to preequilibrate the column prior to use or in eluting bound sample from the column to provide a purified fluid sample.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian J. Sines
Primary Patent Examiner
Art Unit 1797

/Brian J. Sines/

Primary Examiner, Art Unit 1797